



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/687,484	10/13/2000	Donald C. Jackson	0055-0014	9376
58563	7590	10/03/2006		EXAMINER
HARRITY SNYDER, L.L.P. 11350 RANDOM HILLS ROAD SUITE 600 FAIRFAX, VA 22030				PHAN, MAN U
			ART UNIT	PAPER NUMBER
			2616	

DATE MAILED: 10/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/687,484	Applicant(s) JACKSON ET AL.
	Examiner Man Phan	Art Unit 2616
--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --		
<p>THE REPLY FILED <u>15 September 2006</u> FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.</p> <p>1. <input type="checkbox"/> The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:</p> <p>a) <input checked="" type="checkbox"/> The period for reply expires <u>3 months</u> from the mailing date of the final rejection.</p> <p>b) <input type="checkbox"/> The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than <u>SIX MONTHS</u> from the mailing date of the final rejection.</p> <p>Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).</p> <p>Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</p>		
<p>NOTICE OF APPEAL</p> <p>2. <input type="checkbox"/> The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).</p>		
<p>AMENDMENTS</p> <p>3. <input checked="" type="checkbox"/> The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will <u>not</u> be entered because</p> <p>(a) <input type="checkbox"/> They raise new issues that would require further consideration and/or search (see NOTE below);</p> <p>(b) <input type="checkbox"/> They raise the issue of new matter (see NOTE below);</p> <p>(c) <input checked="" type="checkbox"/> They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or</p> <p>(d) <input type="checkbox"/> They present additional claims without canceling a corresponding number of finally rejected claims.</p> <p>NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).</p> <p>4. <input type="checkbox"/> The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).</p> <p>5. <input type="checkbox"/> Applicant's reply has overcome the following rejection(s): _____. </p> <p>6. <input type="checkbox"/> Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).</p> <p>7. <input checked="" type="checkbox"/> For purposes of appeal, the proposed amendment(s): a) <input type="checkbox"/> will not be entered, or b) <input type="checkbox"/> will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.</p> <p>The status of the claim(s) is (or will be) as follows:</p> <p>Claim(s) allowed: <u>36-41</u>.</p> <p>Claim(s) objected to: <u>20, 21, 25, 26, 32 and 33</u>.</p> <p>Claim(s) rejected: <u>1-8, 16-19, 22, 27-31 and 34-41</u>.</p> <p>Claim(s) withdrawn from consideration: <u>9-15, 23, 24 and 42-66</u>.</p>		
<p>AFFIDAVIT OR OTHER EVIDENCE</p> <p>8. <input type="checkbox"/> The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will <u>not</u> be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).</p> <p>9. <input type="checkbox"/> The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will <u>not</u> be entered because the affidavit or other evidence failed to overcome <u>all</u> rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).</p> <p>10. <input type="checkbox"/> The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.</p>		
<p>REQUEST FOR RECONSIDERATION/OTHER</p> <p>11. <input checked="" type="checkbox"/> The request for reconsideration has been considered but does NOT place the application in condition for allowance because: <u>See attached pages</u>.</p> <p>12. <input checked="" type="checkbox"/> Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). <u>8/4/06</u></p> <p>13. <input type="checkbox"/> Other: _____.</p>		

Advisory Action

1. The affidavit, exhibit or request for reconsideration has been considered but does not place the application in condition for allowance because:

Applicant's arguments are not persuasive. In response to applicant's argument that the combination of Aldous et al. (US#6,654,722) and Subramaniam et al. (US#6,070,187) fails to present a *prima facie* case of obviousness. In response, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). It is not necessary that a "*prima facie*" case of unpatentability exist as to the claim in order for "a substantial new question of patentability" to be present as to the claim. Thus, "a substantial new question of patentability" as to a patent claim could be present even if the examiner would not necessarily reject the claim as either fully anticipated by, or obvious in view of, the prior art patents or printed publications. As to the importance of the difference between "a substantial new question of patentability" and a "*prima facie*" case of unpatentability see generally *In re Etter*, 756 F.2d 852, 857 n.5, 225 USPQ 1, 4 n.5 (Fed. Cir. 1985). Also, See MPEP § 2141.01(a) for a discussion of analogous and nonanalogous art in the context of establishing a *prima facie* case of obviousness under 35 U.S.C. 103. See MPEP § 2131.05 for a discussion of analogous and nonanalogous art in the context of 35 U.S.C. 102. 904.02.

It's the examiner's position that the reference is applied herein for the teaching of a novel method and system for a VoIP telephony gateway server and the speech application which can

establish the VoIP communications path through the VoIP-compliant call control interface.

Aldous et al. disclose in Figs. 1 & 2 block diagrams illustrated a VoIP based speech system for servicing a call received over a PSTN comprising: a PSTN-to-IP gateway 3 for connecting to the PSTN 2; an IP network medium 4 connected to the gateway; and a network server 7 in communication with the IP network medium 4 for automated interaction with a user 1 participating in the call (Col. 5, lines 20 plus). Aldous further teaches in Fig. 2 illustrated more detail of the VoIP telephony gateway server 3, in which the VoIP gatekeeper 14 (*proxy server functionality*) can perform load balancing in order to ensure the high availability of VoIP enabled speech servers 5 (*plurality of network servers*) able to receive the voice call (Col. 5, line 59 to Col. 6, line 18). Furthermore, Aldous teaches a VoIP-based speech system, in which a VoIP telephony gateway server; at least one speech server, each speech server containing a VoIP-enabled speech application; a VoIP-compliant call control interface between the VoIP telephony gateway server and the speech server; and, a VoIP communications path between the VoIP telephony gateway-server and the speech application in the at least one speech server (*providing automated dynamic management of the network server*)(see Fig. 2; Col. 2, lines 35 plus). In the same field of endeavor, Submaramaniam et al. (US#6,070,187) discloses a method and apparatus that allows a network node to be automatically configured with an IP address and a default gateway address to be configured as its own gateway. The configuration agent resides on a network device (such as a switch or bridge) that is coupled to two network segments, with one network segments including a node to be configured and another network segment including a server capable of automatically providing configuration parameters. The configuration agent acts as a snoopy agent. Messages from the configuration server to the node to be configured are

"snooped" to discover messages containing an IP address and a default gateway address. Such messages are altered to copy the IP addresses offered to the nodes seeking configuration to the default gateway addresses, and the messages are sent on their way, thereby causing nodes seeking to be configured to be configured as their own default gateway. In some configurations, messages from the node to be configured to the configuration server are altered to ensure that messages from the configuration server to the node seeking to be configured are broadcast messages (See Figs. 3, 6; Col. 6, lines 25 plus).

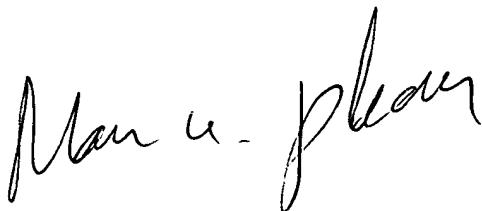
In response to Applicant's argument with respect to the restriction by original presentation, as point out in the previous office action, Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II which has separate utility such as an application server as the media access level for establishing a session with the network interface, which does not include the particular listed of the invention I, such as method for automated interaction with users participating in the calls using network server in communication with the IP network medium. See MPEP ' 806.05(d). Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper. As shown in Fig. 3, a VOIP gateway (VOIP GW) for performing protocol conversion is installed at a border between the IP network and the existing circuit switch network. When both or one of terminals for the call is a terminal compatible with the circuit switch network (for example, a PSTN-compatible telephone), protocol conversion between the circuit switch network and the IP

network is performed at the VOIP gateway (for example, conversion between an analog voice signal and an IP voice packet). Typically, the VoIP gateway includes a subscriber line connector, and a switch for connecting between subscribers who are connected through lines based on address associated with the information data. To facilitate call routing in such VoIP environments, originating and terminating switches (not shown) can be connected to PSTN/IP gateways that belong to both the IP network and the PSTN. Based on the called number or other signaling indicator, the switches route certain calls through the IP gateways instead of the PSTN. It is widely known in the art that Session Initiation Protocol (SIP) telephony is commonly used to establish the call set-up process. SIP is the predominant IETF standard and it is the chosen signaling protocol for upcoming 3GPP and 3GPP2 all-IP networks.

Examiner maintains that the references cited and applied in the last office actions for the rejection of the claims 1-8, 16-19, 22, 27-31 and 34-41 are maintained in this office action. The final rejection mailed on July 25, 2004 is therefore maintained.

Mphan.

09/28/2006



MAN U. PHAN
PRIMARY EXAMINER